

REMARKS

Claims 1-52 are pending.

RESTRICTION/ELECTION REQUIREMENT RESPONSE

The Office Action restricts to the following inventions:

Group A, claims 1-18 and 26, drawn to a method [and apparatus for claim 26] for recording management information on a write-once optical medium, classified in Class 369, subclass 44.26.

Group B, claims 19-25 and 27, drawn to a method [and apparatus for claim 27] for details such as performing or not performing of defects management in an optical recording medium, classified in Class 369, subclass 47.14.

Group C, claims 28-45 and 89-94, drawn to an apparatus and structure of the recording medium, and controlling management information on a compact disc, classified in Class 369, subclass 94. [*Note: claims 89-94 are not found in this Application, so this reference to claims 89-94 is considered to be an inadvertent typographical error. Clarification is requested*].

Group D, claims 46-52, drawn to a structure of the recording medium for controlling management information and details of the defect management, such as performing or not performing defect management on a compact disc, classified in Class 369, subclass 53.17.

In addition, the Office Action requires Applicants to elect a single species from whichever of the group selected, e.g., Group A, B, C or D. In this regard, the Office Action asserts that the application contains claims directed to the following patentably distinct species:

Species a. – Fig. 7

Species b. - Fig. 8

Species c. - Fig. 9.

ELECTION

In reply to this requirement, Applicants hereby elect the invention of Group A, Species of Fig. 7, claims 1-18 and 26, with traverse.

ALTERNATE ELECTION

As an alternative to the previous election, Applicants elect the invention of Groups A and C, Species of Figs. 7 and 9, claims 1-18, 26 and 28-45, with traverse.

TRAVERSAL

Applicants traverse this restriction/election requirement because the Office Action for a number of reasons, including that the Office Action does not correctly categorize the claims.

Claims 1-18 are directed to a method of recording management information on an optical recording medium that includes a temporary defect management area (TDMA) and a final defect management area (DMA), the method comprising two recited steps. Claim 26 is directed to an apparatus for recording management information on an optical recording medium that includes a temporary defect management area (TDMA) and a final defect management area (DMA). Claim 28 is directed to a write-once optical recording medium for recording management information therein, the medium including a temporary defect management area (TDMA) and a final defect management area (FDMA). Claim 28 indicates the type of information that is to be recorded in the TDMA and the DMA.

These inventions are related as different statutory categories of an invention, i.e., claims 1-18 are directed to a method of recording information on an optical recording medium with specific characteristics, claim 26 is directed to an apparatus for recording information on an optical recording medium with those characteristics, and claim 28 is directed to an optical recording medium with those characteristics.

Inventions C and A are not, as alleged, related as process and apparatus for its practice. Instead, Invention C is directed to an optical recording medium with certain characteristics, and Invention A is directed to both a method and an apparatus for using the optical recording medium of Invention C. This type of subject matter is dealt with in MPEP §806.05(h). Unfortunately, the Office Action does not apply the test set forth in MPEP §806.05(h) to Inventions C and A and, as a result, fails to make out a *prima facie* case of proper restrictability between Inventions C and A, a burden that is clearly stated to be on the Examiner in that section of the MPEP.

In other words, because the outstanding Office Action has not demonstrated (or even addressed the issue) that the process of claims 1-18 cannot be used with another materially different product, or that the product recited in claim 28 be used in a materially different process, the restriction requirement is improper in this regard and should be withdrawn.

Similarly, Inventions C and B are not related as a process and an apparatus for its practice. Rather, Inventions C and B are related as a product (optical recording medium with certain features) to an apparatus/method for using that optical recording medium. Because the outstanding Office Action has not demonstrated (or even addressed the issue) that the apparatus of claim 27 (Invention B) cannot be used with another materially different product, or that the product recited in claim 28 (Invention C) be used in a materially

different apparatus, the restriction requirement is improper in this regard and should be withdrawn.

Moreover, claims 19-25 (Invention B) are directed to a method of recording management information on an optical recording medium that includes a temporary defect management area (TDMA) and a final defect management area (DMA), the method comprising the recited steps. Claim 27 (Invention B) is directed to an apparatus for recording management information on an optical recording medium that includes a temporary defect management area (TDMA) and a final defect management area (DMA). Claim 46 (Invention D) is directed to a write-once optical recording medium for recording management information therein, the medium including a temporary defect management area (TDMA) and a final defect management area (DMA). Claim 46 indicates the type of information that is to be recorded in the TDMA and the DMA.

Inventions D and B are not related as a process and an apparatus for its practice. Rather, Inventions D and B are related as a product (optical recording medium with certain features) to an apparatus/method for using that optical recording medium. Because the outstanding Office Action has not demonstrated (or even addressed the issue) that the apparatus of claim 27 cannot be used with another materially different product, or that the product recited in claim 46 be used in a materially different apparatus, the restriction requirement is improper in this regard and should be withdrawn.

Similarly, Inventions D and A are not, as alleged, related as process and apparatus for its practice. Instead, Invention D is directed to an optical recording medium with certain characteristics, and Invention A is directed to both a method and an apparatus for using the optical recording medium of Invention D. This type of subject matter is dealt with in MPEP §806.05(h).

Unfortunately, the Office Action does not apply the test set forth in MPEP §806.05(h) to Inventions D and A and, as a result, fails to make out a *prima facie* case of proper restrictability between Inventions D and A, a burden that is clearly stated to be on the Examiner in that section of the MPEP.

In other words, because the outstanding Office Action has not demonstrated (or even addressed the issue) that the process of claims 1-18 cannot be used with another materially different product, or that the product recited in claim 46 be used in a materially different process, the restriction requirement is improper in this regard and should be withdrawn.

The Office Action also concludes that Inventions A and B are related as combinations and subcombinations. The combination recited in claim 1, for example, is broader in scope than the combination recited in claim 19 in the sense that claim 19 recites, in addition to some features recited in claim 1, the extra step of setting of a predetermined value in a defect list area of the DMA.

However, the combination of claim 19, as claimed, sets forth the details of the combination as separately claimed in claim 1. Thus, restriction would not be proper even if claim 1 were considered to be a subcombination of what is recited in claim 19 (which it is not) – see MPEP §806.05(c), paragraph I, entitled, “Subcombination essential to Combination,” Rev.3, August 2005.

Thus, the Office Action fails to set forth a *prima facie* case of proper restriction between Inventions A and B.

Moreover, Inventions C and D are both directed to an optical recording medium (no apparatus claim). Accordingly, the reasons set forth in the Office Action do not make sense. Thus, the Office Action fails to make out a *prima facie* case of proper restriction between Inventions C and D.

For all of the above reasons, the Office Action fails to make out a *prima facie* case that it is proper to restrict between the claimed inventions, as suggested.

Reconsideration and withdrawal of this restriction/election requirement are respectfully requested.

Furthermore, because restriction is not proper, and the election of species is predicated on a proper restriction requirement, the election of species requirement is improper.

Additionally, with respect to the election of species requirement, the Office Action fails to demonstrate that Figs. 7, 8 and 9 are claimed in a mutually exclusive manner - see MPEP §806.04(f). In this regard, claim 1's features are found in all of dependent claims 2-18, and claim 19's features are found in all of dependent claims 20-25. Furthermore, a no-defect management feature is recited in both claims 12 and 19, the no-defect management feature is not exclusively recited in either Invention A or Invention B. For this additional reason, the Office Action fails to demonstrate that the subject matter of Figs. 7, 8 and 9 are not recited in a mutually exclusive manner and, according to MPEP §806.04(f), an election of species is not proper. In other words, because the process claims are not mutually exclusive, they all must be examined together.

As further evidence that the species of Figs. 7, 8 and 9 are not claimed in a mutually exclusive manner, the following reasons are presented:

1. Claim 1, which is an independent claim, reads on Fig. 7, Fig. 9A and Fig. 9B;
2. Claims 2-8, which depend from claim 1, read on Fig. 7;
3. Claims 9-16, which depend from claim 1, read on Figs. 9A and 9B;

4. Claim 17, which depends from claim 1, reads on Figs. 7, 9A and 9B;
5. Claim 18, which depends from claim 1, reads on Figs. 7, 9A and 9B;
and
6. Claim 26, which is an independent claim, reads on Figs. 7, 9A and 9B.

This further evidence clearly shows that the species of Figs. 7 and 9 are not claimed in a mutually exclusive manner, and forms the basis for the alternate election, above.

Accordingly, the Office Action fails to demonstrate a proper election of species requirement and it is improper to require Applicants to elect a single species under these circumstances.

Furthermore, under MPEP § 803 which indicates that even if restriction is proper, claims directed to independent and distinct inventions must be examined in one Application, there is no undue search burden because the search for these claims is coextensive, and all pending claims should be examined on their merits.

CONCLUSION

Applicants respectfully submit that the restriction and election of species requirement is improper and should be withdrawn, and that claims 1-52 should be examined on their merits.

In the event that any outstanding matters remain in this application, the Examiner is invited to contact the undersigned at (703) 205-8000 in the Washington, D.C. area.

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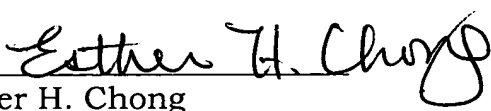
Docket No. 0465-1034P

Reply to Restriction/Election Requirement of June 6, 2006

Please charge any additional fees or credit any overpayments pursuant to 37 C.F.R. §§ 1.116 or 1.117 to Deposit Account No. 02-2448.

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Respectfully submitted,

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